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In re Application of BLACKBURN :
U.S. Application No.: 10/526,838 :
PCT Application No.: PCT/AU03/01096 :
Int. Filing Date: 27 August 2003 :
Priority Date Claimed: 03 September 2002 :
Attorney Docket No.: 75390-010100 :
For: LATCH ASSEMBLY WITH DEAD LATCH :
INDICATOR :

DECISION

This is in response to applicant's "Request for Reconsideration of Decision to Dismiss Petition" filed 06 July 2006.

BACKGROUND

On 27 August 2003, applicant filed international application PCT/AU03/01096, which claimed priority of an earlier Australia application filed 03 September 2002. A copy of the international application was communicated to the USPTO from the International Bureau on 18 March 2004. The thirty-month period for paying the basic national fee in the United States expired on 03 March 2005.

On 03 March 2005, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 08 September 2005, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 10 April 2006, applicant filed a petition under 37 CFR 1.47(b).

On 09 May 2006, this Office mailed a decision dismissing the 10 April 2006 petition.

On 06 July 2006, applicant filed the present renewed petition under 37 CFR 1.47(b).

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17(i), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. See 37 CFR 1.47(b).

Petitioner has previously satisfied items (1), (2), (3), and (6) above.

With regard to item (4) above, the declaration submitted with the petition is improper. Specifically, the declaration fails to state the name and citizenship of the inventor as required by 37 CFR 1.497(a)(3). The requirements of 37 CFR 1.497(a)(3) will not be waived.

With regard to item (5) above, the 37 CFR 1.47(b) applicant must prove that, as of the date the application was deposited in the Patent and Trademark Office, (A) the invention has been assigned to the applicant, or (B) the inventor has agreed in writing to assign the invention to the applicant, or (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify filing of the application. MPEP 409.03(f).

In the present case, item (C) above applies. With respect to item (C), MPEP 409.03(f) states,

If the invention has not been assigned, or if there is no written agreement to assign, the 37 CFR 1.47(b) applicant must demonstrate that he or she otherwise has a sufficient proprietary interest in the matter.

A proprietary interest obtained otherwise than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant. The facts in support of any conclusion that a court would award title to the 37 CFR 1.47(b) applicant should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (if other than the United States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States Patents Quarterly) relied on to demonstrate a proprietary interest should be made of record.

The petition states that Assa Abloy Australia Pty Limited ("Assa Abloy") has proprietary interest in the present invention. Petitioner has provided an appropriate legal memorandum (see affidavit of Christopher David Schlicht) along with an affidavit of the person with firsthand knowledge of the facts contained therein (see affidavit of Hans Juergen Esser). The memorandum establishes with reasonable certainty that a court of competent jurisdiction would award title of the invention to Assa Abloy.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.47(b) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file a proper response will result in ABANDONMENT of the application. Extensions of time are available under 37 CFR 1.136(a). Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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